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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 927,368	08.13.2001	Hisaya Mori	50090-332	4507

7590 12.18.2002

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600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER

CHAN, EMILY Y

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/927,368

Applicant(s)

MORI ET AL.

Examiner

emily y chan

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Japan reference 2000-356724 is crossed off of the IDS filed on 10/9/01 because it is not related to the present invention.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 6, it is unclear whether the signal exchanged with the semiconductor integrated circuit is from the test circuit board. It is assumed by the examiner that the test circuit board is connected to the semiconductor integrated circuit under test so a signal is exchanged between them. It is also unclear whether the test circuit board or the semiconductor integrated circuit under test includes the "analog-to-digital converter circuit " and the " digital-to-analog converter circuit " Since there are two "analog-to-digital converter circuit " (ADC 62 and ADC 51) and two " digital-to-analog converter circuit " (DAC 52 and DAC 61) are shown in Fig 2, it is unclear which "analog-to-digital converter circuit " and which " digital-to-analog converter circuit " are comprised in the apparatus for testing the semiconductor integrated circuit. It is assumed by the examiner that the test circuit board includes the "analog-to-digital converter circuit " and the " digital-to-analog converter circuit ".

Claim 1 recites the limitation "the analog test data output" which lacks antecedent basis and should be recited as "analog test data output".

Claim 2 recites the limitation "the first and second memory sections" which lacks antecedent basis and should be recited as "first and second memory sections".

Claim 6 provides for the use of an apparatus for testing a semiconductor integrated circuit, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Examiner considers this claim have structure limitation recited.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Allowable Subject Matter***

Claims 1-5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is an examiner's statement of reasons for the indication of allowable subject matter. Claim 1 in combination with the rest claims are

Art Unit: 2829

indicated allowable because the claimed feature that the test ancillary device disposed in the vicinity of the test circuit board includes a test data memory with two memory sections such that when digital test data are stored in one memory section, the digital test data that have already been stored in the other memory section are loaded for analysis is not taught or suggested by prior art.

### ***Prior Art of Record***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inoue et al disclose a testing system and teach a memory for storing digital test data from an analog -digital -converter circuit.

Satitoh et al disclose a system for testing integrated circuit using an A/D converter built in a semiconductor chip.

Yamamura discloses a test ancillary device (Fig 4, 15) disposed in the ancillary of a test circuit board (Fig4, 10).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to emily y chan whose telephone number is 7033056123. The examiner can normally be reached on 8:30-5:30.

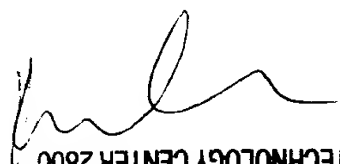
Art Unit: 2829

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, cuneo kammie can be reached on 7033081233. The fax phone numbers for the organization where this application or proceeding is assigned are 7033085841 for regular communications and 7033085841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 7022056123.

ec

December 13, 2002

  
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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800